



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,244	04/03/2001	Alain Bethune	05725.0875-00	8888

22852 7590 12/23/2003

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

SPERTY, ARDEN B

ART UNIT	PAPER NUMBER
----------	--------------

1775

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,244

Applicant(s)

BETHUNE ET AL.

Examiner

Arden B. Sperty

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 16-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

NON-FINAL OFFICE ACTION

1. Finality of the previous office action has been withdrawn based on the structure recited in the After Final Interview, Paper No. 13, July 30, 2003. The previous rejections do not apply to the structure recited by counsel.
2. This action is in response to the After Final Interview conducted July 30, 2003 at the USPTO.
3. The restriction of claims 16-24 remains. Claims 1-15 have been examined upon their merits.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how a coating "partially delimits" a decorative pattern. It is further unclear how the first metallic coating delimits the decorative pattern (paragraph 13) and what the resultant structure is when the decorative pattern, which was somehow delimited, is covered with a second metallic coating (paragraph 13, lines 5-7).

The claims are further indefinite because they are not consistent with the specification. The claims are drawn to two distinct coating systems, each having a different number of metallic

Art Unit: 1775

layers, however the specification describes an object having at least three metallic layers, wherein the outer layer has been partly removed to define a pattern.

The examiner has interpreted the claims, in light of the interview of July 30, 2003, to be drawn to an object comprising a support having at least a first metallic coating formed of at least $n \geq 2$ superposed layers of metal and defining a decorative pattern and a second metallic coating covering the area corresponding to the decorative pattern and formed of $n-1$ superposed layers of metal and wherein an outer surface facing away from the support comprises both the first and second metallic coatings and the first metallic coating appears different from the second metallic coating. It is the examiner's interpretation that other layers may be found between any of the claimed layers, as long as the above requirements are met. For instance, a clear protective coating may overlay the first coating as long as the color of the first layer still shows through the discontinuous areas of the second coating. Further, the second coating need not be the outermost coating of the invention; i.e. it is not required that the surface of the second coating be exposed to the environment upon completion of the invention. The second coating may be covered by another layer or coating, including a clear layer, another metallic layer, a plastic layer, adhesive layer, or any other layer or coating.

Specification

6. The disclosure is objected to because of informalities as detailed herein.

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise

Art Unit: 1775

and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. An example of an unclear term used in the specification is:

partially delimiting- it is not clear how a coating "partially" delimits a decorative pattern.

The disclosure is objected to because Counsel indicated in the After Final interview that 10 and 11 (of Figures 2a-b) correspond to the second coating, however no such distinction is made in the specification. The specification includes reference to a second coating and reference to 10 and 11, but no nexus is made joining these two ideas.

The disclosure is objected to because it does not appear to be consistent with the claims. There is no description of a first and second metallic coating each consisting of multiple metal layers simultaneously on a support as is claimed. Applicant is advised to review the specification, drawings and claims for consistency.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 8-12 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,505,320 to Burns et al.

Art Unit: 1775

Regarding claim 1, the Burns reference discloses a support having a first metallic coating of $n=2$ layers, designated 2 and 3, and a second metallic coating of $n=1$ layer, designated 4, wherein the outer metallic layer (3) of the first metallic coating is Cu and has a color and appearance differing from that of the outer metallic layer of the second metallic coating of Cr (col 3, line 22- col 4, line 18). As shown in Figure 5, the first metallic coating delimits a decorative pattern and the second metallic coating corresponds to the decorative pattern.

Regarding claim 2, USPN 4,971,188 to Deters is cited to show that plastics similar to those disclosed by Burns may be metallurgically coated by a galvanoplasty process (col 2, lines 8-10 and 45-48). Therefore the limitations of the claim are met.

Regarding claim 3, the Burns reference discloses the object according to claim 1 wherein the support is a polyester (col 2, line 64).

Regarding claims 8-12 and 14-15, the shape of an object is a matter of personal preference predicated on ultimate intended use. Absent an indication of unexpected results with respect to the shape of the object, no patentable distinction is seen.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3704403, DE 3030403 and USPN 6546751.

Art Unit: 1775

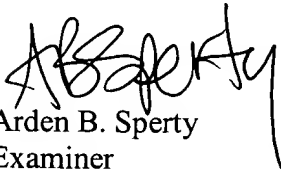
Each of the cited references teach molded substrates having decorative patterns formed thereon, the decorative patterns defined by at least two metals of contrasting colors. Although the references may not specifically teach the number of claimed layers, no patentable distinction is seen absent a showing of significance with respect to the additional layers of the first metallic coating. The shape of the article to which the decorative metals are applied is merely a matter of personal preference and would have been obvious to one of ordinary skill in the art. Therefore, the limitations of the claims are met.

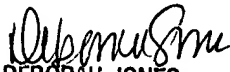
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is 703-305-3143. The examiner can normally be reached on M-R, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 703-308-3822. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Arden B. Sperty
Examiner
Art Unit 1775


DEBORAH JONES
SUPERVISOR, PATENT EXAMINER

09 December 2003